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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,922	08/04/2003	Moungi G. Bawendi	14952.0274 C1 D1/MIT 8096	4946
27890	7590	09/12/2005	EXAMINER	
STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			TRAN, MY CHAU T	
			ART UNIT	PAPER NUMBER
			1639	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary <i>Restriction Only</i>	Application No. 10/632,922	Applicant(s) BAWENDI ET AL.	
	Examiner MY-CHAU T. TRAN	Art Unit 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, 12, 13, and 26-39, drawn to a library of compounds, classified in class 435, subclass DIG 22.
 - II. Claims 4, 14-18, drawn to a method for identifying a compound having a characteristic of interest with the step of testing each member of the library of compounds to identify compounds having a characteristic of interest, classified in class 435, subclass DIG 14.
 - III. Claims 5-11, drawn to a method for identifying a compound having a characteristic of interest with the step of contacting said first library of molecules with said second library of molecules, classified in class 436, subclass 536.
 - IV. Claims 19-25, drawn to a method for identifying a compound having a characteristic of interest with the step of correlating the spectral emission with a member compound, classified in class 436, subclass 164.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group II, Group III, and Group IV are three different methods, which differ in their method steps. The different method steps have different functions and modes of operation. Group II requires the method step of testing each member of the library of compounds to identify compounds having a characteristic of interest. Group III requires the method step of contacting said first library of molecules with said second library of molecules.

Art Unit: 1639

Group IV requires the method step of correlating the spectral emission with a member compound. Thus these three different inventions as claimed have different method steps that have different functions and modes of operation (MPEP § 806.04, MPEP § 808.01).

3. Inventions Group I (product) and Group II (process) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown:

(1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as the process of peptide synthesis. This restriction requirement is also applicable with the method of Group III, and Group IV.

4. Because these inventions are distinct for the reasons given above and the searches required are not co-extensive thus requiring a burdensome search, restriction for examination purposes as indicated is proper. Additionally, different patentability considerations are involved for each group. For example, a patentability determination for Group I would involve a determination of the patentability of the library of compounds while a patentability determination for Group III would involve a consideration of the patentability of the method for identifying a compound having a characteristic of interest with the step of contacting said first library of molecules with said second library of molecules. These considerations are very different in nature.

Art Unit: 1639

Even though some of the groups are classified in the same class and/or subclass, this has no effect on the non-patent literature search. Different groups would require completely different searches in non-patent databases, and there is no exception that the searches would be co-extensive.

5. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, i.e. Group I (1-3, 12, 13, and 26-39), and the product claims are subsequently found allowable, withdrawn process claims, i.e. Group II (Claims 4, 14-18), Group III (Claims 5-11), and Group IV (Claims 19-25), that depend from or otherwise include all the limitations of the allowable product's claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. The amendment(s) that is submitted after final rejection is governed by 37 CFR 1.116; the amendment(s) that is submitted after allowance is governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product's claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product's claim is found allowable, an otherwise proper restriction requirement between the product's claims and the process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claims

Art Unit: 1639

will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996).

Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product's claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the examiner before the patent issues withdraws the restriction requirement. See MPEP § 804.01.

6. This application contains claims directed to the following patentably distinct species of the claimed invention.

7. ***If applicants elect the invention of Group I***, applicants are required to elect ***one single*** species from ***each*** of the following a)-b) that result in a ***single specific*** species of a library of compound:

a) A ***single specific*** species of compound/member, for example the species claimed in claims 13, 27-30, 34, and 35.

b) A ***single specific*** species of support, for example the species claimed in claims 12 and 33.

The species are distinct, each from the other, because each species have different chemical structure and/or physiochemical properties and would be capable of separate

Art Unit: 1639

manufacture and/or use; and would necessitate different and separately burdensome manual and computer bibliographic and structure searches in both patent and non-patent areas.

8. *If applicants elect the invention of Group II*, applicants are required to elect *one single* species of member (e.g. the species claimed in claims 16-18) that result in a *single specific* species of a library of compound.

The species are distinct, each from the other, because each species have different chemical structure and/or physiochemical properties and would be capable of separate manufacture and/or use; and would necessitate different and separately burdensome manual and computer bibliographic and structure searches in both patent and non-patent areas.

9. *If applicants elect the invention of Group III*, applicants are required to elect *one single* species from *each* of the following a)-b) that result in a *single specific* species of a library of compound:

a) A *single specific* species of first library molecule, for example the species claimed in claim 6.

b) A *single specific* species of second library molecule, for example the species claimed in claim 7.

The species are distinct, each from the other, because each species have different chemical structure and/or physiochemical properties and would be capable of separate manufacture and/or use; and would necessitate different and separately burdensome manual and computer bibliographic and structure searches in both patent and non-patent areas.

Art Unit: 1639

10. ***If applicants elect the invention of Group IV***, applicants are required to elect ***one single*** species of member (e.g. the species claimed in claims 22-24) that result in a ***single specific*** species of a library of compound.

The species are distinct, each from the other, because each species have different chemical structure and/or physiochemical properties and would be capable of separate manufacture and/or use; and would necessitate different and separately burdensome manual and computer bibliographic and structure searches in both patent and non-patent areas.

11. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and ***a listing of all claims readable thereon, including any claims subsequently added***. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

12. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

13. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

Art Unit: 1639

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

14. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

15. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 571-272-0810. The examiner can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1639

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct

September 6, 2005


PADMASHRI PONNALURI
PRIMARY EXAMINER